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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,731	07/28/2003	Manish K. Deliwala	03292.101710.	4018
66569 7590 06/19/2009 FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
OBEID, FAHD A				
ART UNIT		PAPER NUMBER		
3627				
MAIL DATE		DELIVERY MODE		
06/19/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/628,731

Applicant(s)

DELIWALA ET AL.

Examiner

FAHD A. OBEID

Art Unit

3627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

1. This is in reply to application filed on 03/18/2009.
2. No claims have been added or canceled.
3. Claims 2-6, 20-23 have been cancelled.
4. Claims 1-4 have been amended.
5. Claims 1-4 are currently pending and have been examined.

Specification Objections

6. The amendment filed 03/18/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "job identifiers" and "task identifiers".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that

the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's amendment filed on 03/18/2009 contains the limitation "job identifiers" and "task identifiers" is considered new matter since it does not have any support in the specification. Applicant specification discloses "usage time is associated with a unique identifier" "associate each unique identifier with a group or subgroup" (PGPup; para 20). Therefore, the specification lacks support for "job identifiers" and "task identifiers".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "application profiles that associate one or more computer-related hardware processing tasks" is vague and indefinite. It is unclear whether this limitation refers to "a plurality of computer-related hardware processing jobs" or other tasks. The phrases "computer-related hardware processing tasks" and "computer-related hardware processing jobs" render the claim vague and indefinite. Thus the limitation is not positively recited.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacFarlane (US 6,125,354) in view of Peterson (US 7,020,628).

1. Regarding Claim 1: MacFarlane discloses a method for tracking costs incurred by an entity comprising a plurality of groups, the method comprising:
 - Reading a business model (organization hierarchy) file comprising at least one business dimension within the entity, the at least one business dimension including (col 1 lns 27-42 and col 3 lns 54-63):
 - Organizational information including a list of a plurality of groups within the entity, and application profiles that associate one or more computer-related hardware processing

tasks, capable of being executed by the provider, to each group and to a corresponding one or more unique task identifiers (fig.5 and col 6 lns 61-64);

- Allocating the billing information by the at least one business dimension including matching each of the plurality of job identifiers to the one or more unique task identifiers (fig.5, col 2 lns 58-67, col 6 lns 57-64, and col 9 lns 25-35).

MacFarlane does not explicitly disclose receiving billing information associated with consumption of computer-related hardware processing resource from a provider.

However, Peterson does disclose the following:

- Receiving billing information associated with consumption of computer-related hardware processing resource from a provider, the billing information including a plurality of computer-related hardware processing jobs executed by the provider for the entity and a corresponding plurality of job identifiers (abstract, col 1 lns 17-18, and col 4 lns 7-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Peterson's teachings in MacFarlane's "system and method for generating an invoice charges to the elements of an organization" enabled, for the advantage of monitoring the costs of remote users accessing the computer of the company (Peterson; col 1 lns 27-29).

2. Regarding Claim 2: MacFarlane discloses the method of claim 1 wherein the at least one business dimensions further comprises:

- At least one business process (col 4 lns 7-9 and col 3 lns 54-63).

- An associated business performance metrics (abstract and col 2 lns 45-57).
3. Regarding Claim 3: MacFarlane discloses the method of claim 2 wherein the allocating step further comprises:
- determining a total cost incurred by at least one of the plurality of groups (col 1 lns 27-35, col 2 lns 58-67, col 6 lns 57-59, and col 9 lns 25-35).
4. Regarding Claim 4: MacFarlane discloses the method of claim 1 wherein the reading step further comprises:
- Determining an internal structure of the entity, including the plurality of groups within the entity (col 1 lns 27-35).
 - Determining a billing detail of the plurality of groups within the entity (fig.1, col 4 lns 45-48, and col 7 lns 10-14).
 - Determining a value driver of the entity (claim 1).
 - Determining an application profile of the entity (col 4 lns 6-8).

Response to Arguments

5. Applicant's arguments have been fully considered but they are not persuasive. In particular the applicant alleges that MacFarlane and Peterson do not teach: a) the billing information including a plurality of computer-related hardware processing jobs executed by the provider for the entity and a corresponding plurality of job identifiers and application profiles that associate one or more computer-related hardware processing tasks, capable of being executed by the provider, to each group and to a corresponding one or more unique task

identifiers and In response to a) examiner respectfully disagrees MacFarlane does teaches a user code to indicate the element or hierarchical level of the organization to which the miscellaneous charge is to be assigned or allocated (fig.5 and col 6 lns 61-64); therefore the code represents a division, branch, department, or element such as accounting department, human resources department, or payroll department (col 3 lns 21-26 and col 4 lns 7-8), for example a task such as payroll department is associated with a unique code, another task such as accounting department is associated with a unique code.

Therefore, MacFarlane still meets the scope of the limitation as currently claimed.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/
Examiner, Art Unit 3627
June 15, 2009

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627